

REMARKS/ARGUMENTS

I. Summary of the Office Action

In the Office Action, claims 1-23, 30-51 and 72-105 are pending. Claims 1-23, 30-51, and 72-105 are rejected. Claims 106-107 have been added.

Claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, 45-49, 73-75, 78-80, 83-85, 87, 89-91 and 94-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (4988255) in view of Peres (3739471).

Claims 4-6, 33, 44, 72, 77, 82, 88-89 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 3, 32, 43, 1, 30, 37 above, and further in view of McGrath et al. (6494017).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 1 above, and further in view of Blaimschein (5318420).

Claims 17-18, 35, 50, 76, 81, 86 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Pares, as applied to claims 1, 30, 37 and 87 above, and further in view of Kitamura et al. (5423216).

Claims 21-23, 36 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1, 30 and 37 above, and further in view of Yuyama et al. (6644504).

Claims 40-42 and 99-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1 and 37 above, and further in view of Coughlin (2004/0059463).

Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Peres, McGrath et al., Blaimschein, Kitamura et al. and further in view of Lasher et al. (5720154).

Claims 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 30, 37 and 87 above, and further in view of Brazell (5611378) and British Patent (2068829).

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Peres, McGrath et al., Blaimschein, Kitamura et al., Lasher as applied to claim 93 above, and further in view of Brazell (5611378) and British Patent (2068829).

Claim 105 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 37 above, and further in view of Lasher et al. (5720154).

II. Summary of Applicants Reply

Applicants respectfully submit that no new matter has been introduced into the subject application. Amendments to and cancellations of the claims are being made solely to expedite prosecution, and do not constitute acquiescence to any of the Examiner's objections to or rejections of the claims. Specifically, new claims 98-105 are supported by the original specification and drawings, for example, as discussed below in greater detail.

At the outset, Applicant notes that it has **already established** an invention/priority date of as early as **June 2, 1999**. Accordingly, McGrath, Yuyama and Coughlin are **NOT** prior art to the present invention. With respect to McGrath, McGrath claims continuation-in-part (CIP) status to an earlier filing date than June 2, 1999. However, **the Examiner has the burden** of showing that McGrath is entitled to the earlier filing date.

Therefore, for these reasons alone, the following rejections are submitted to be inappropriate, and withdrawal of same is respectfully requested:

Claims 4-6, 33, 44, 72, 77, 82, 88-89 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 3, 32, 43, 1, 30, 37 above, and further in view of **McGrath et al. (6494017)**.

Claims 21-23, 36 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1, 30 and 37 above, and further in view of **Yuyama et al. (6644504)**.

Claims 40-42 and 99-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1 and 37 above, and further in view of **Coughlin (2004/0059463)**.

Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Peres, **McGrath et al.**, Blaimschein, Kitamura et al. and further in view of Lasher et al. (5720154).

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Peres, **McGrath et al.**, Blaimschein, Kitamura et al., Lasher as applied to claim 93 above, and further in view of Brazell (5611378) and British Patent (2068829).

With respect to the remaining rejections, Applicant provides the following arguments traversing the rejections below. Reconsideration of the present application is respectfully requested.

III. The Rejection of Claims under 103(a): Hoffman In View Of Peres

Claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, 45-49, 73-75, 78-80, 83-85, 87, 89-91 and 94-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (4988255) in view of Peres (3739471).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 1 above, and further in view of Blaimschein (5318420).

Claims 17-18, 35, 50, 76, 81, 86 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1, 30, 37 and 87 above, and further in view of Kitamura et al. (5423216).

Claims 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 30, 37 and 87 above, and further in view of Brazell (5611378) and British Patent (2068829).

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Peres, McGrath et al., Blaimschein, Kitamura et al., Lasher as applied to claim 93 above, and further in view of Brazell (5611378) and British Patent (2068829).

Claim 105 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 37 above, and further in view of Lasher et al. (5720154).

With respect to rejected claims **4-6, 21-23, 33, 36, 40-42, 44, 51, 72, 77, 82, 88-89, 93, 98-100 and 104**, as indicated above, the Examiner has **NOT** cited a “prior” art reference to support the rejection. Therefore, the Examiner has failed to

provide a prima facie case of unpatentability, and withdrawal of the rejection of these claims is respectfully requested.

Claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, 45-49, 73-75, 78-80, 83-85, 87, 89-91 and 94-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (4988255) in view of Peres (3739471).

In rejecting the above claims the Examiner relied on Hoffman in view of Peres. The **Examiner admitted** that:

Hoffman does not disclose to cut at least one of the top, sidewall or bottom of the container. However, Peres disclose that it is well known in the art of emptying the containers to cut the top (95) of the container (see col. 4, lines 38-55) to empty the container.
(Office Action, page 2)

Applicant disagrees that there is a reason to combine Hoffman and Peres. MPEP §2145(X)(D)(2) entitled “References Cannot Be Combined Where Reference Teaches Away from Their Combination” recites “It is improper to combine references where the references teach away from their combination.” See re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Hoffman teaches away from, at least, destroying the bottle reciting:

U.S. Pat. No. 4,573,852 discloses an apparatus for rupturing a plastic bottle or vessel in order to recover their contents. This apparatus comprises a rupturing member, means for locating a bottle or vessel to be ruptured, means for limiting the movement of the bottle or vessel and means for moving the limiting means and the rupturing member relative to one another whereby to rupture the bottle or vessel. **However, this apparatus has the drawbacks that the bottle or vessel is destroyed and there is a high probability that the pharmaceutical product will be contaminated by bits of the ruptured container.** (Hoffman, background.)

That is, Hoffman teaches away from destroying the bottle (e.g., cutting) and is, at least, concerned with contaminating the pharmaceutical. **Unlike Hoffman** that teaches away from, at least, destroying the bottle and contaminating the pharmaceutical, **Peres discloses severing of container tops** an action that would, at least, destroy the bottle. Hoffman specifically teaches away from destroying the bottle (e.g., cutting, rupturing, and severing), reciting: “**However, this apparatus has the drawbacks that the bottle or vessel is destroyed and there is a high probability that the pharmaceutical product will be contaminated by bits of the ruptured container.**” Accordingly, Hoffman teaches away from Peres.

Further, Applicants respectfully traverse the Examiner’s statement “that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the seal cutter of Hoffman with the top cutter of Peres to cut the top of the container to empty the container.” Applicant requests that the Examiner provide supporting references and/or an affidavit under 37 C.F.R. § 1.104(d)(2). In the absence of either, Applicants request withdrawal of rejections made, in part, based on the Notices. In addition, Applicant requests withdrawal of the rejections utilizing Hoffman and Peres in combination.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 1 above, and further in view of Blaimschein (5318420).

Blaimschein relates to an apparatus for cutting a workpiece made of a polymer. The apparatus combines a cutting tool operable to perform a feed movement along a desired line of cut relative to a portion of the **workpiece** to be cut, the cutting tool includes a cutter blade

subjected to ultrasonic vibration as it cuts the portion of the workpiece, with a thermal control arranged to maintain the portion of the workpiece at a pre-selected temperature. The invention requires heating or cooling means that can be used to heat the workpiece if it is made of thermoplastic materials, so that they will be sufficiently soft for being cut by the ultrasonic cutter, or to prevent an undesired heating of a workpiece that is made of a thermoset polymer so that even thermoset polymers can easily be cut by the ultrasonic cutter.

Thus, Blaimschein would not appear to be appropriate for pharmaceuticals – heating and/or cooling a container of pharmaceuticals is not an acceptable operation for a container with pharmaceuticals. Accordingly, for these reasons as well, Applicant submits that the combination of limitations in claim 9 patentable distinguishes over the prior art. Withdrawal of this rejection is respectfully requested.

Claims 17-18, 35, 50, 76, 81, 86 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Pares, as applied to claims 1, 30, 37 and 87 above, and further in view of Kitamura et al. (5423216).

Kitamura permits continuous **automatic determination of the bulk specific gravity of a powdery sample** and highly precise measurement thereof. The apparatus comprises a robot transporting a container filled with a powdery sample; a funnel provided with a damper, which receives the powdery sample discharged from the container; a damper-driving unit for pulling out and pushing the damper; a sample sensor for detecting the powdery sample dropped through the funnel provided with a damper; a constant volume receiver for receiving dropped through the funnel provided with a damper; a scraping bar for sliding the upper face of the constant volume receiver; a scraping bar-driving unit for reciprocating the scraping bar; a constant volume receiver-conveying robot transporting the constant volume receiver;

an electronic balance which determines the weight the powdery sample in the constant volume receiver; and a cleaner for aspirating the weighed powdery sample.

For example, dependent claim 17 recites, in combination, “a sensor system to determine when the contents are no longer being emptied directly from the pharmaceutical container.” Dependent claim 18 recites, in combination, the “sensor system comprises a light emitter and a light receiver, said light emitter providing a light beam that is broken by the contents being emptied directly from the pharmaceutical container.” Dependent claim 50 recites, in combination, “a sensor system, interfacing with said control system, to determine when the contents of the pharmaceutical container are no longer being emptied directly from the pharmaceutical container.”

Kitamura does not disclose or suggest this combination of limitations in the claims. In addition, the Examiner has not provided a reason to combine Kitamura, particularly since Kitamura is unrelated to the present invention since **Kitamura relates to determining the weight of powdery substances.**

Accordingly, for these reasons as well, Applicant submits that the combination of limitations in the rejected claims patentable distinguish over the prior art. Withdrawal of this rejection is respectfully requested.

Claims 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 30, 37 and 87 above, and further in view of Brazell (5611378) and British Patent (2068829).

Brazell relates to a router table assembly includes a **tiltable table** subassembly which allows positioning of the router axis horizontally or perpendicularly with respect to the base,

while allowing angular adjustment of the table subassembly. A base pivotably supports the table subassembly, the subassembly including a primary table pivotably attached to the base, a fence affixable perpendicularly with respect to the primary table, a router mounting plate shiftably attached to the primary table and adapted to receive a router, and an adjustment mechanism cooperating with the router mounting plate and the primary table enabling a user to transversely vary the position of the router mounting plate for router adjustment.

British merely relates to a **dust proof plaster cast cutter** and safety device when cutting a cast that has been applied to the skin of a patient.

For example, dependent claim 101 recites, in combination, “means for at least one of providing vacuum flow collecting pill dust and providing vacuum flow in the area of the cutter.” Dependent claim 102 recites, in combination, “a rotating unit, operable with said gripper and said control system, that rotates at least a portion of said gripper unit to empty the contents of the pharmaceutical container; and a vacuum unit for at least one of providing vacuum flow collecting pill dust created when said gripper unit empties the contents of the pharmaceutical container and providing vacuum flow in the area of the cutter.” Dependent claim 103 recites, in combination, “a vacuum unit for at least one of providing vacuum flow collecting pill dust and providing vacuum flow in the area of the cutter.”

Neither Brazell nor British Patent disclose or suggest the combination of limitations in the claims. In addition, the Examiner has not provided a reason to combine Brazell and British Patent with the remaining prior art references. In addition, the proposed combination does not yield the claimed limitation.

Accordingly, for these reasons as well, Applicant submits that the combination of limitations in the rejected claims patentable distinguish over the prior art. Withdrawal of this rejection is respectfully requested.

Claim 105 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 37 above, and further in view of Lasher et al. (5720154).

Lasher et al. is an automated system, but lack the combination of the container bulking system. Hoffman and Peres have been distinguished previously. In addition, except for the present invention, there is no reason or suggestion to combine a container bulking system in an automated system. In fact, prior to the present invention, the assignee of the present invention had been substantially practicing the Lasher et al. system and did not use any container bulking system as claimed in combination herein.

Specifically, dependent claim 105 recites, in combination, “an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers for a patient specific prescription order.” This combination is unique and the Examiner has failed to provide any reason for the combination.

Accordingly, for these reasons as well, Applicant submits that the combination of limitations in the rejected claims patentable distinguish over the prior art. Withdrawal of this rejection is respectfully requested.

New claims 106-107 has been added to provide a method of the present invention that Applicant believes patentably distinguishes over the prior art for one or more of the above reasons as well.

CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

Applicants also traverse any “Official Notice,” “Design Choice,” “Admitted Prior Art” or other alleged prior art that the Examiner purports is well known with respect to the claimed combination of the present invention. Applicants disagree and request the Examiner to provide a prior art reference describing any of these features that the Examiner has not provided a prior art reference or an affidavit under 37 C.F.R. Section 1.104(d)(2) providing details of why it would have been obvious. In the absence of either, Applicants request withdrawal of this rejection for these reasons as well.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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